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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,710	09/05/2000	Suman Preet Singh Khanuja	056859/0107	8287

22428 7590 06/27/2003

FOLEY AND LARDNER
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WASHINGTON, DC 20007

EXAMINER

COE, SUSAN D

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 06/27/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/655,710

Applicant(s)

KHANUJA ET AL.

Examiner

Susan Coe

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1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 7,8,11-26 and 28-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9, 10 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The amendment filed April 21, 2003, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
2. Claims 1-48 are pending.
3. Claims 7, 8, 11-26, and 28-48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.
4. Claims 1-6, 9, 10, and 27 are examined on the merits.

Claim Rejections - 35 USC § 102

5. Claims 1-5 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,939,050 for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the reference does not teach the claimed invention because the reference teaches using the extract in anti-microbial effective amounts. Applicant uses 1ug/ml and 25 ug/ml of *G. glabra* extract in their specification. Therefore, applicant has functionally defined these amounts as the effective amount of *G. glabra* extract. The reference teaches using *G. glabra* extracts in these amounts. Therefore, the reference amounts meet what applicant has defined as the effective amount.

Applicant also argues that the reference does not teach using glycyrrhizin. However, applicant's claim 1 only states that an extract or compound from *G. glabra* is used. Claims 2 and 3 specify that the compound can be glycyrrhizic acid or glycyrrhizin. The reference specifically

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states that the *G. glabra* extract contains glycyrrhizic acid (see column 4, lines 34-42). In addition, glycyrrhizin is a component naturally found in *G. glabra*; therefore, the reference extract would contain glycyrrhizin. Applicant also argues that there would be additional components in the “crude” extract used in the reference. However, since applicant’s claims use the transitional phrase “comprising,” additional elements can be present in the composition.

Applicant also argues that it is not possible to determine the ratio of *G. glabra* to “Agent B” in the reference; thus, the claim 6 is not anticipated. However, claim 6 is not included in this rejection.

In response to applicant's argument that the reference uses the composition for a different purpose, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The reference composition is considered to be the same as the claimed composition for the reasons discussed above; therefore, there is no structural difference that patentably distinguishes the claimed invention from the prior art.

Claim Rejections - 35 USC § 103

6. Claims 1, 5, 6, 9, 10, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,939,050, The Merck Index (Budavari et al. (eds) (1989), 11th edition, Merck

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& CO., Inc: New Jersey, entry numbers 2315, 6273, and 6617) and US Pat. No. 5,478,829 for the reasons set forth in the previous Office action.

The previous Office action inadvertently stated December 15, **2002** rather than December 15, **2001**. This was a typographical error.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the claims are not obvious because applicant is not using the *G. glabra* extracts as antibacterial agents. However, the prior art teaches using *G. glabra* extracts in amounts that meet what applicant has defined as the effective amounts. Therefore, it is considered obvious to use these amounts for the reasons of record. Simply because the prior art uses a composition for a different purpose does not make a composition allowable. Since applicant is claiming a composition rather than a method of use, the composition is still considered to be obvious based on the reasons of record.

In addition, applicant argues optimization of the ingredient amounts would yield a *G. glabra* product where the *G. glabra* has anti-bacterial properties. However, the prior art teaches using amounts of *G. glabra* that meet applicant's definition of effective amount. It is considered to be obvious for a person of ordinary skill to add additional antibacterial agents to the amount of *G. glabra* used in the prior art that would meet the limitations set forth in applicant's claim 6.

7. No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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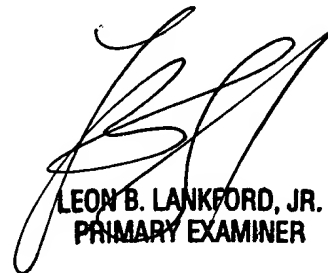
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Susan Coe, Examiner
June 26, 2003



LEON B. LANKFORD, JR.
PRIMARY EXAMINER